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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,802

08/19/2005

Toshio Narita

043061

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38834

7590

06/13/2006

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,802

Applicant(s)

NARITA, TOSHIO

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities: Regarding Claim 1, the phrase "of including a Re-Cr based" appears to be informal, where either "of" or "including" can be deleted to correct it. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
3. form the basis for the rejections under this section made in this Office action:
4. A person shall be entitled to a patent unless –
5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
6. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Meelu USPN 6,299,986 for the reasons of record in the Office Action mailed on 29 December 2005.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1-4, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narita et al. WO 03/038152 for the reasons of record in the Office Action mailed on 29 December 2005.

Response to Amendment

- I. Applicant's amendments and arguments are satisfactory for overcoming the section 112, second paragraph rejection of the Office Action mailed on 29 December 2005.
- II. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Meelu of the Office Action mailed on 29 December 2005. Applicant argues that the heat generating members of the articles of Meelu were not made by diffusion of Re and Cr therein. Applicant points out that Meelu describes Meelu's substrates as having a higher Re content than the barrier coating, which is contrary to what would be expected after a diffusion treatment. However, the claim merely refers to Re and Cr "diffused therein." The presence of a gradient in Re concentration is not a claimed feature and hence is not a required element in the prior art article. For the purposes of finding an anticipatory teaching,

the presence of Re and Cr in the substrate material teaches the claimed feature. Homogenizing diffusion of Re and Cr in the substrate material is encompassed by the claim language. As well, it is not necessary that the prior art article be formed by homogenizing diffusion as applicant has not demonstrated that diffusion treated articles, as currently claimed, are necessary structurally or compositionally different from those of the prior art. Rejection is maintained.

- III. Applicant has traversed the section 103 rejection over Narita et al. WO 03/038152 of the Office Action mailed on 29 December 2005. Applicant has submitted a 37 CFR 1.132 declaration by Inventor Narita that has been considered. The declaration is understood to assert that Inventor Narita is an inventor of subject matter not claimed in WO 03/038152. The declaration is understood to assert that the inventorship of this application, i.e., of United States Patent Serial Number 10/519,802, is correct. However, in view of the assertion of correctness of the inventorship of this application, to obviate rejection, it must be established that Inventor Narita is the sole inventor of subject matter not claimed in WO 03/038152. Moreover, the subject matter of the claims is relied upon to reject the claims. As well, the disclosure of WO 03/038152

teaches that the claimed sigma phase can be expected to be inherently obtained when the relative amounts of Re and Cr are utilized as set forth in the claims of WO 03/038152. Hence, withdrawal of the rejection is not appropriate.

Allowable Subject Matter

10. Claims 5, 6, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is


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(571) 272-1539. The examiner can normally be reached on Monday through Friday.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael La Villa
7 June 2006


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER